

Applicant : Raymond G. Schuder et al.
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Attorney's Docket No.: 10002621-2
Amendment dated: Nov. 1, 2006
Reply to Office action dated: Aug. 11, 2006

Remarks

I. Status of Claims

Claims 9-13, 21-30, and 36-38 were pending.

Claim 39 has been added.

The Examiner has indicated that claims 11-13, 21-26, 30, and 38 would be allowable if rewritten in independent form.

II. Claim rejections under 35 U.S.C. § 102/103

The Examiner has rejected claims 9, 10, 27-29, 36, and 37 under 35 U.S.C. § 102(b) or § 103(a) over Watson (U.S. 3,847,718).

A. Independent claim 9

In support of the rejection of claim 9, the Examiner has stated that:

Regarding claim 9, Watson discloses a bookbinding system, comprising: a sheet binder (not shown, see column 4, lines 36-38) configured to bind two or more sheets into a text body 15 having an exposed spine bounded by two exposed side hinge areas (not labeled, see figure 3); an adhesive dispenser (in the form of a roll, not shown, see column 2, lines 63-67) configured to apply a solid pressure sensitive adhesive film 40 between a cover 32 (see column 3, lines 5-13, substrate 12 may be made of a width sufficient to form cover 32) and the side hinge areas of the text body 15; and a cover binder (not shown, see column 4, lines 38-46 and column 5, line 65 to column 6, line 2) configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

Independent claim 9 recites:

9. A bookbinding system, comprising:
a sheet binder configured to bind two or more sheets into a text body having an exposed spine bounded by two exposed side hinge areas;

an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and

a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

The first clause of the body of claim 9 plainly recites that the sheet binder is configured to bind two or more sheets into a text body. Therefore, the “text body” defined in claim 9 is not formed until the two or more sheets are bound by the sheet binder. The second clause of claim 9 plainly recites that the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body. Since the text body does not exist until after the two or more sheets are bound by the sheet binder, the plain meaning of claim 9 necessarily requires that the adhesive dispenser be configured to apply the solid pressure sensitive adhesive film between the cover and the side hinge areas after the two or more sheets have been bound into the text body.

In Watson's approach, the text body is formed after the pressure sensitive adhesive strips 40 have been attached to the unbound sheets of the book 15. In particular, Watson explains that (emphasis added):

In use, cover strips 41 are removed to expose the adhesive 40 which, on application of pressure following insertion of the book 15 therebetween as described earlier, bonds the sides of substrate 12 to the outer pages of the book 15. The application of heat and pressure to the center portion or base of substrate 12 activates the low tack adhesive comprising stripe 14 to complete the bond in the manner described heretofore.

The reference to the earlier description in the underlined portion of this explanation corresponds to col. 4, lines 37-38, where Watson explains that “the loose pages comprising the book 15 are placed, edge first, on adhesive strip 14.”

Therefore, contrary to the Examiner's position, Watson does not teach or suggest an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body, as recited in claim 9.

For at least these reasons, the Examiner's rejection of claim 9 under 35 U.S.C. §102/103 over Watson should be withdrawn.

The Examiner's rejection of claim 9 also should be withdrawn for the following additional reasons:

1. Watson does not disclose a “sheet binder” of a bookbinding system as defined in claim 9. In his rejection of claim 9, the Examiner has stated that Watson discloses a sheet binder in col. 4, lines 36-38. This disclosure, however, merely states that “the loose pages comprising the book 15 are placed, edge first, on adhesive strips.” This disclosure does not describe a sheet binder, contrary to the Examiner’s assumption.
2. Watson does not disclose an “adhesive dispenser” of a bookbinding system as defined in claim 9. In his rejection of claim 9, the Examiner has stated that Watson discloses an adhesive dispenser in col. 2, lines 63-67. This disclosure, however, merely states that the adhesive “binding means, which could be conveniently supplied in the form of a roll, would be cut to size at the time of use.” This disclosure does not describe an adhesive dispenser that applies a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body. Contrary to the Examiner’s assumption, a roll of the binding means 10 is not configured to apply the binding means 10 to the loose pages of the book 15. Instead, some mechanism must manipulate the roll in order to apply the binding means 10.
3. Watson does not disclose a “cover binder” of a bookbinding system as defined in claim 9. In his rejection of claim 9, the Examiner has stated that Watson discloses a cover binder in col. 4, lines 38-46, and col. 5, line 65 - col. 6, line 2. This disclosure, however, merely describes the process of bonding the loose pages of the book 15 to one another and the substrate 12. This disclosure does not provide any details of the mechanism used to implement this process, contrary to the Examiner’s assumption.

For at least these additional reasons, the Examiner’s rejection of claim 9 under 35 U.S.C. §102/103 over Watson should be withdrawn.

In an effort to sidestep these failures of Watson’s disclosure, the Examiner has stated that:

It should be noted that the claim as currently written does not require the sheet binder and cover binder to be mechanically or automatically performed. However, in the alternative, it would have been obvious to have replaced a manual system for sheet and cover binding with an automatic system for the purpose of increasing production capability, as it has been held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

In this statement, however, the Examiner has not explained how one skilled in the art at the time the invention was made would have been led to replace the unspecified “manual system for sheet and cover binding” with the unspecified “automatic system”. Nor has the

Examiner provided any explanation regarding how such a person would have been led to make such a replacement in a way that arrives at the invention bookbinding system recited in claim 9. Consequently, contrary to the Examiner's assumption, the statement quoted above does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103 (see MPEP § 706.02(j)).

B. Claims 10, 27-29, 36, and 37

Each of claims 10, 27-29, 36, and 37 incorporates the features of independent claim 9 and therefore is patentable over Watson for at least the same reasons explained above. Each of these claims also is patentable over Watson for the following additional reasons.

Claim 10 recites that "the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film to the cover in a series of spaced-apart strips." The Examiner has taken the position that this feature is shown in FIG. 7 of Watson. Watson, however, does not teach or suggest anything about the way in which the pressure sensitive adhesive 40 is applied to the substrate 12. Moreover, Watson does not even hint that the pressure sensitive adhesive 40 is applied by the undisclosed adhesive dispenser that the Examiner has assumed is used to apply the binding means 10 between the substrate 12 and the side hinge areas of the unbound sheets of the book 15.

Claim 27 recites that "the cover binder contacts the side hinge areas to the applied solid pressure sensitive adhesive film." As explained above in connection with claim 9, Watson does not describe a cover binder. Indeed, Watson does not provide any details of the mechanism that is used to implement the process of binding the loose sheets of the book 15 with the binding means 10, contrary to the Examiner's assumption.

Claim 28 recites that "the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive." The Examiner has taken the position that this feature is disclosed in col. 2, lines 63-67. As explained in connection with claim 9, however, this disclosure merely states that the adhesive "binding means, which could be conveniently supplied in the form of a roll, would be cut to size at the time of use." This disclosure does not describe an adhesive dispenser, contrary to the Examiner's assumption.

Claim 29 recites that "the adhesive dispenser dispenses from the roll a solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier

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ribbon." The Examiner has taken the position that the substrate portion 18 of the substrate 12 and the end portions 19 of the substrate 12 correspond to a carrier ribbon on which is dispersed the pressure sensitive adhesive. In this case, however, the Examiner impermissibly has relied on a single element of Watson's binding means 10 (i.e., the substrate 12) to meet two separate and distinct elements of claim 29 (i.e., the "cover" and the "carrier ribbon"), effectively reading one of these claim elements out of the claim. For this additional reason, the Examiner has failed to establish a *prima facie* case of obviousness of claim 29 under 35 U.S.C. § 103(a) (see MPEP § 2143.03).

Claim 36 recites that the bookbinding system includes "a roll of the solid sheet adhesive loaded in the adhesive dispenser." Although Watson discloses that the binding means 10 can be supplied from a roll (col. 2, lines 63-67), Watson does not describe an adhesive dispenser, contrary to the Examiner's assumption.

Claim 37 recites that "the cover binder positions the cover over the exposed side hinge areas and the exposed spine of the text body and applies pressure to the positioned cover to activate the pressure sensitive adhesive film." The Examiner has taken the position that Watson discloses this feature in col. 5, line 65 - col. 6, line 2. This disclosure, merely states that pressure is applied to bond the sides of the substrate 12 to the outer pages of the book 15. This disclosure does not even hint that this process is carried out by a cover binder of a bookbinding system.

III. Conclusion

All of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,



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